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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH JOHN FATULA, JR.

Appeal 2009-007432
Application 10/735,938
Technology Center 2400

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and DEBRA K. STEPHENS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL [1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1-9, and 20-35. Claims 10-19 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

Invention

> An apparatus, system, and method are disclosed for autonomic management of data operations and performance resources on a grid computing system. An autonomic management apparatus includes a monitor module, a policy module, and a regulation module. The monitor module is configured to monitor the grid computing system for a trigger event. The policy module is configured to access one of a plurality of system policies. Each of the plurality of system policies corresponds to an operational control parameter of a system resource of the grid computing system. The regulation module is configured to autonomically regulate the system resource in response to a recognized trigger event according to one of the plurality of system policies. The trigger event may be a prediction trigger event, an initiation trigger event, a regulation trigger event, or a termination trigger event.

(Abstract, Spec. 33; *see also* Figs. 3-7).

Representative Claim

> 20. A method for autonomic management of system resources on a grid computing system, the method comprising:
>
> monitoring the grid computing system for a trigger event;
>
> accessing one of a plurality of system policies, each of the plurality of system policies corresponding to an operational control parameter of a system resource of the grid computing system, wherein the plurality of system policies comprises a system prediction policy; and

regulating the system resource in response to a recognized trigger event according to one of the plurality of system policies.

Prior Art and the Examiner's Rejections

The Examiner relies on the following references as evidence of unpatentability:

Chase, *Dynamic Virtual Clusters in a Grid Site Manager*, Proceedings of the 12th IEEE International Symposium on High Performance Distributed Computing (HPDC '03) 90-100, (June 22, 2003).

Fu, *Sharp: An Architecture for Secure Resource Peering*, Proceedings of the 19th ACM Symposium on Operating System Principles (SOSP'03) 133-148, (Oct. 19, 2003)

All claims on appeal, claims 1-9, and 20-35, stand rejected under 35 U.S.C. § 103. As evidence of obviousness the Examiner relies on Chase in view of Fu.

ANALYSIS

We vacate the prior art rejection encompassing all claims on appeal because we conclude that all claims on appeal, claims 1-9, and 20-35, are "barred at the threshold by § 101." *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (citing *Diamond v. Diehr*, 450 U.S. 175, 188 (1981)). Therefore, the following new ground of rejection is set forth in this Opinion within the provisions of 37 C.F.R. § 41.50(b).

NEW REJECTION UNDER 35 U.S.C. § 101

PRINCIPLES OF LAW

Statutory Subject Matter

The subject matter of claims permitted within 35 U.S.C. § 101 must be a machine, a manufacture, a process, or a composition of matter. Moreover, our reviewing court has stated that "[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007); *accord In re Ferguson*, 558 F.3d 1359 (Fed. Cir. 2009). This latter case held that claims directed to a "paradigm" are nonstatutory under 35 U.S.C. § 101 as representing an abstract idea. Thus, a "signal" cannot be patentable subject matter because it is not within any of the four categories. *In re Nuijten*, 500 F.3d at 1357. Laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. at 185. A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). Significantly, "[a]bstract software code is an idea without physical embodiment." *Microsoft Corp. v. AT&T Corp.,* 550 U.S. 437, 449 (2007). The unpatentability of abstract ideas was reaffirmed by the U.S. Supreme Court in *Bilski v. Kappos*, 130 S.Ct. 3218 (2010).

With this background in mind, all claims on appeal, 1-9, and 20-35, are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Consistent with our earlier-noted invention statement taken from Appellant's Abstract of the disclosure, the disclosed and claimed invention is directed to software *per se*, abstract ideas, abstract concepts and methodologies and the like, including various data structures and named entities, such as various labeled modules and various functionalities associated therewith, software, software applications, and abstract intellectual processes associated with them within the claims on appeal.

As set forth in the second sentence of the abstract of Appellant's disclosure reproduced in our invention statement, the claimed autonomic management apparatus is comprised of computer software-based modules which are directly claimed in the body of apparatus independent claim 1 on appeal and in a corresponding means plus function manner in the body of independent claim 30. The functionality is in turn reflected in flow chart Figures 5-7. It is significant to note that the depiction of the global autonomic management apparatus 312 in Figure 3 is illustrated to comprise only modules and, correspondingly, a client version of the management of such an autonomic management apparatus is depicted in Figure 4 in the same manner. Thus, no true apparatus in a hardware sense is disclosed to embody the recited autonomic management apparatus in the preamble of the claims on appeal that purport to recite apparatus, such as independent claims 1 and 30 on appeal.

These views with respect to these claims are buttressed by the following paragraphs reproduced from Appellant's Specification as filed:

> Modules may also be implemented in software for execution by various types of processors. An identified module of executable code may, for instance, comprise one or more physical or logical blocks of computer instructions which may, for instance, be organized as an object, procedure, or function.

> Nevertheless, the executables of an identified module need not be physically located together, but may comprise disparate instructions stored in different locations which, when joined logically together, comprise the module and achieve the stated purpose for the module.
>
> Indeed, a module of executable code could be a single instruction, or many instructions, and may even be distributed over several different code segments, among different programs, and across several memory devices. Similarly, operational data may be identified and illustrated herein within modules, and may be embodied in any suitable form and organized within any suitable type of data structure. The operational data may be collected as a single data set, or may be distributed over different locations including over different storage devices, over disparate memory devices, and may exist, at least partially, merely as electronic signals on a system or network.

(Spec. 7, ¶¶ [0026] and [0027]).

The reader will thus appreciate that the claimed modules within independent claim 1 and the correspondingly recited means in independent claim 30 are directed to software instructions, software *per se* and the like. The functionalities are reflected in a direct manner associated with the logic processes associated with these modules in method independent claims 20 and 23 on appeal that also appear to correspond to some of the functionality depicted in flow charts Figures 5-7.

As a separate matter, the preamble of independent claim 24 states that the recited computer readable storage medium "comprises" computer readable code *per se* consistent with the methodologies set forth in method independent claim 20, for example. Significantly, the last sentence within Specification paragraph [0027] that we reproduced earlier indicates that this medium is intended to comprise electronic signals *per se*. Media that include and encompass signals *per se* are proscribed by the earlier-noted

case law. Note also the analysis provided by *Subject Matter of Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

CONCLUSION AND DECISION

We have *pro forma* vacated the outstanding rejection over applied prior art of all claims on appeal, claims 1-9, and 20-35. We have instituted a new ground of rejection within 37 C.F.R. § 41.50(b). This new rejection of all claims on appeal is based upon 35 U.S.C. § 101 since these claims are directed to non-statutory subject matter.

A new ground of rejection is pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that: "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197(b)) as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

VACATED; 37 C.F.R. § 41.50(b)

peb

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